

Reply to Office Action of June 24, 2009

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REMARKS

In the Office Action of June 24, 2009, which action was made final, all claims were rejected as being obvious over Gough '143 or Gough '143 in view of Swanson.

The Examiner's action on pages 2 to 7 seems to address only claim 1.

All of the remarks from page 2 to page 7 of the Office action identify only claim 1.

In the past replies and most recent interview, Applicants also presented claims 28 and 29, which distinguish from the Examiner's reading of the insulation sleeve in Gough et al. 143 (see Final Action at page 2, first paragraph) as to the second support shaft.

Claim 28 differs in reciting "The electrode assembly of claim 16, wherein the first support shaft has a tubular metal inner portion and an insulated outer portion and wherein the second support shaft has a tubular metal inner portion and an insulated outer portion-and wherein the first support shaft is disposed within the second support shaft to provide a concentric tube configuration.

This clearly distinguishes from Gough '143 Figs. 7 and 8, which does not show or suggest this subject matter.

Claim 29 recites wherein the first support shaft is positioned in a side-by-side configuration with the second support shaft. This also distinguishes from Gough '143 Figs. 7 and 8, which shows a concentric configuration. Side-by-side is to be interpreted as shown in Fig. 1 of the present application.

On page 8, almost as an afterthought, the Examiner states "to employ the trocars side-by-side configuration rather than coaxial, since this is not critical; it is well within the skill of one having ordinary skill in the art."

Clearly, the Examiner concedes it is not shown in Gough et al. '143, and also the undersigned would note that the Examiner does not appear to be reading claim 29 as a whole with the limitation of claim 1, but in isolation.

Both configurations in claims 28 and 29 provide clear advantages over Gough et al. 143. It is most probably the insulation 18 is fixed on the trocar 14 in Gough et al., and adjusted in length by stripping it off. Whether the insulation is slideable or fixed, it is disadvantageous in comparison with the present invention of claim 28 and 29, where the shafts can be moved

without affecting the electrical insulation.

Furthermore, the final action goes beyond the bounds of reasonable inferences to be drawn from the Gough et al. '143 reference.

On page 5 of the Office Action, the Examiner completely infers the insulation of the trocar 14 between two axially spaced apart sets of three electrode tips, contrary to what is shown in the drawings in Fig. 5 of Gough et al. '143. The Examiner draws this inference from a misinterpretation on page 4 of a single sentence out of context at col. 7, lines 30-32, which is referring to Fig. 2, and shows only one antenna 16', and a single sentence out of context at col. 8, lines 2-4 which refers to an ablation volume from just one set of three antennas in one plane.

With respect to the bipolar mode issues in Gough et al. '143, it is reiterated that the bipolar energization in Gough et al. is most likely between electrode tips in the same plane and not in axially spaced planes. Second, as to the Examiner's comment that bipolar energization is contained in claim 16, and is presumptively enabled, the presumption is overcome as there is insufficient circuitry disclosed to enable that embodiment in the patent or support the claim. The claim should have been rejected for lack of illustration in the drawing. The discussion of bipolar energization in Gough et al. was simply a broadening statement, relying on information in the art rather than actual disclosure in the Gough et al. '143 patent.

The bipolar energization language in Gough is not in fact, enabled under 35 USC 112, first paragraph, because Gough does not show in Fig. 10 how it is in fact connected to the antennas 16. Compare, for example, the electrical schematics provided in Figs. 2, 5 and 7 of the present application.

Now that the Examiner has replied by what he understands as "an axially separated plane." in Fig. 8, on page 6, the Examiner has identified two axially separated antennas. However, claim 1 recites: "wherein the second plane is opposite the first plane by a predetermined separation through the tissue to define a three-dimensional volume of tissue to be ablated." This is not seen in Fig. 8 of Gough et al. because the antennas 16' are in sets of two and two (col. 8, lines 35-37), and if opposite each other, all lie in one vertical plane on the sheet of paper. This does not meet the claim language in claim 1, lines 7-18 and claim 16, lines 5-15,

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which recite two sets of three electrodes forming plane which are further recited as axially space apart.

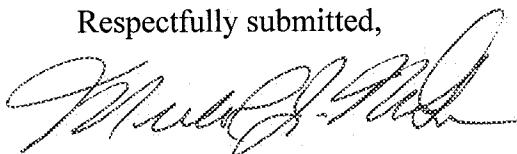
Fig. 8 of Gough et al. '143 does not show enough antennas 16 to define a three-dimensional volume achieved without rotation. It shows only two antennas 16' at the top and two antennas 16' at the top of insulation sleeve (col. 8, lines 35-37).

SUMMARY

A Request for Continued Examination accompanies this submission. The Examiner is respectfully requested to reconsider the final action and the remarks therein as not addressing the scope of the claims presented or the content of the Gough '143 reference.

In view of the Amendment and Remarks, reconsideration of the application is respectfully requested. After the amendment, claims 1-9, 13, and 16-22 and 28-29 are still pending, and a Notice of Allowance for these claims or an indication of allowable subject matter is earnestly solicited.

Respectfully submitted,



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